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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,872	02/19/2004	Michael E. Graham	10.209.003	1973
30236	7590	09/26/2005	EXAMINER	
KILE GOEKJIAN REED & MCMANUS 1200 NEW HAMPSHIRE AVE, NW SUITE 570 WASHINGTON, DC 20036			MILLER, CHERYL L	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/780,872

Applicant(s)

GRAHAM, MICHAEL E.

Examiner

Cheryl Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/28/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5-9, 12, and 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Bramlet et al (US 6,443,954 B1). Bramlet discloses an implant (5 shown in fig.1 and 9a, 9b) comprising a first member (mid-conical portion 38) and a second member (threaded portion 40) and a third member (cylindrical portion above the conical portion 38 in fig.9a; head of screw). Bramlet discloses the second member to be threaded (see fig.9a) and discloses the implant to be made of a medical polymer, specifically UHMWPE, col.4, lines 32-42). Bramlet discloses a recess (42) adapted for receiving a tool.

Claims 1-4 and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Olerud (US 5,057,109 A). Olerud discloses an implant (16, seen in fig.5), comprising a first member (conical portion 18), a second member (19) and a third member (17), the third member being threaded as seen in fig.5.

Claims 1, 2, 5, 10, 12, 14, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated

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by Carlsson et al. (US 6,053,920 A). Carlsson discloses an implant (1 seen in fig.1a, 1b) comprising a first member (conical portion 9), a second member (threaded portion 4) and a third member (portion 2), the implant having a longitudinal bore (10-13) extending through the implant (see fig.1b).

Claims 1, 2, 5-7, 12, and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Leriche (US 5,300,076 A). Leriche discloses an implant (1 seen in fig.1, 2) comprising a first member (conical portion 12), a second member (cylindrical portion 9) having threads (6) and a third member (cylindrical portion 14).

Claims 1, 2, 8, 12, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Chan (US 6,607,535 B1). Chan discloses an implant (1000 comprising components 1004a+1004b; see figs.12, 14) comprising a first member (taper conical portion on component 1004b), a second member (cylindrical portion on component 1004a); and a third member (cylindrical portion on component 1004b). Chan discloses the implant to be made of a medical polymer (col.7, lines 17-23).

Claims 1, 8, 10, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Zang et al. (US 2005/0177165 A1). Zang discloses an implant (100, 120, or 140, seen in figs.3a-3c) comprising a first member (conical portion 104, 124, or 144) and a second member (cylindrical portion 106, 126, or 146). Zang discloses the implant to be made of a medical polymer (P 0023) and having the dimensions claimed to fit in the sinus tarsi (P 0018).

It is noted to the applicant, that in the above rejections, please note the intended use language as set forth in the claims carries no weight in the absence of any distinguishing structure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlsson et al. (US 6,053,920 A). Carlsson discloses an implant substantially as claimed, however Carlsson does not disclose the exact dimensions claimed. It would have been an obvious matter of design choice to have the claimed dimensions, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claims 11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leriche (US 5,300,076 A). Leriche discloses an implant substantially as claimed, however Leriche does not disclose the exact dimensions claimed. It would have been an obvious matter of design choice to have the claimed dimensions, since such a modification would have involved a mere

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change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claims 9, 11, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan (US 6,607,535 B1). Referring to claims 11 and 20, Chan discloses an implant substantially as claimed, however Chan does not disclose the exact dimensions claimed. It would have been an obvious matter of design choice to have the claimed dimensions, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Referring to claims 9 and 18, Chan discloses an implant made of a medical polymer (col.7, lines 18-23), however does not disclose the specific polymers claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the implant of one of the claimed polymers, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zang et al. (US 2005/0177165 A1). Zang discloses an implant made of a medical polymer (P0023), however does not disclose the specific polymers claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the implant of one of the claimed polymers, since it has been held to be within the general skill of a worker in the art to

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select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (571) 272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cheryl Miller



BRUCE SNOW
PRIMARY EXAMINER